

**REMARKS**

Claims 17 to 32 are now pending.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for making of record the references of the IDS and 1449 papers filed to date.

It is respectfully requested that the Examiner acknowledge whether the Drawings are accepted.

Claims 17 to 32 were rejected under the first paragraph of 35 U.S.C. § 112 as lacking enablement.

The Final Office Action essentially conclusorily asserts that one of ordinary skill in the art would need to resort to undue experimentation to calculate the direct axis and quadrature axis voltages using only a setpoint value of a quadrature axis current, together with a rotational speed information and a stationary model.

It is noted that the prior explanation was wholly ignored and not addressed in any way (let alone refuted) in the Final Office action. In particular, and as previously explained, the direct-axis component of the regulated voltage ( $u_d$ ) and the quadrature-axis component of the regulated voltage ( $u_q$ ) are ascertained in a decoupling network 19; in this context, for this ascertainment, only the setpoint value of quadrature-axis current component as well as information on the rotational speed are required. With the aid of a stationary machine model, the two voltage components are then ascertained, that is, the direct-axis component of the regulated voltage ( $u_d$ ) and the quadrature-axis component of the regulated voltage ( $u_q$ ). In the case of the stationary machine model, a model in table form is involved which includes the required interrelationships. The machine model is set up, for instance, empirically for the respective permanent magnetically energized synchronous machine. The machine-specific parameters are filed in the stored table. It is respectfully submitted that one of ordinary skill, based on reading the specification, would understand the above-stated details sufficient to practice the claimed invention.

Accordingly, withdrawal of the enablement rejections as to claims 17 to 32 is respectfully requested for these reasons alone.

As further regards the enablement rejection under the first paragraph of 35 U.S.C. § 112, it is respectfully submitted that the standard for determining whether a patent application

complies with the enablement requirement is that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407))). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

It is believed that the present assertions of the Office Action do not adequately address whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it does. In short, it is believed that the Office Action’s arguments and assertions do not really

address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims. As explained, the Final Office Action did not address in any way (let alone refute) the explanation as to why the subject matter is enabled.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims.

*In particular, the subjective assertions of the Office Action are simply not supported by any real "evidence or sound scientific reasoning" — which the law requires and which makes plain that the Office (and not an applicant) bears the burden of persuasion on an enablement rejection.*

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (See id. at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Office Action has not satisfied the foregoing for establishing that undue experimentation would be required, and it is therefore respectfully requested that the enablement rejections as to claims 17 to 32 be withdrawn for all of the above reasons.

**CONCLUSION**

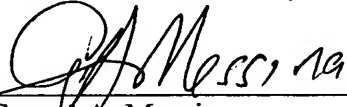
In view of the above, it is respectfully submitted that all of the presently pending claims 17 to 32 are allowable. It is therefore respectfully requested that the rejections be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully submitted,

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